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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,699	07/29/2005	Terje Angelskaar	MBZ-0488	6908

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EXAMINER	
GREEN, ANTHONY J	
ART UNIT	**PAPER NUMBER**
1755	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/516,699	ANGELSKAAR ET AL.	
	Examiner	Art Unit	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/02/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to what is meant by the phrase "on the basis of 17% aluminium sulphate". The claim is confusing as it recites at least one of (a) and (b) however since the phrase "up to about 15%" is used for each of (a) and (b) and this phrase includes zero "0" as a lower limit, components (a) and (b) would not need to be present. Clarification is requested.

Claim Objections

3. Claims 4, 14 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The range of "up to about 5%" recited in claim 4 is outside the range of 1 to about 8.5%" found in claim 3.

The range of "up to about 5%" recited in claim 14 is outside the range of 1 to about 8.5%" found in claim 13.

The range of "up to about 5%" recited in claim 19 is outside the range of 1 to about 8.5%" found in claim 18.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 5-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sommer et al (US Patent No. 6,537,367 B2).

The reference teaches, an accelerator composition comprising water, aluminum sulfate, aluminum hydroxide, a 40% hydrofluoric acid solution, a complexing agent and an amine, see the abstract, examples and the claims. According to column 4, lines 11+ the complexing agent may be selected from nitriloacetic acid, EDTA, hydroxycarboxylic acids etc. The amine may be selected from alkanol amines (see column 4, lines 25-30).

The instant claims are obvious over the reference. The examples teach compositions that render obvious the instant claims. As for aluminium sulphate being calculated on the basis of 17% aluminium sulphate, applicants particularly claimed type is a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results absent evidence showing otherwise, as 17% aluminum sulphate is a well known typical grade of aluminium sulphate. .Since the hydrofluoric acid is present in a 40% solution it

is believed that the amount of hydrofluoric acid would fall within the instantly claimed range. As for the complexing agent, while the example teaches EDTA, column 4, lines 11+ teach that hydroxycarboxylic acids may be used and accordingly it would have been obvious to substitute a hydroxycarboxylic acid for the EDTA of the reference. As for the amounts of the other components the reference teaches amounts that encompass those instantly claimed. However, one of ordinary skill in the ad at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

6. Claims 1, 5-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sommer et al (US Patent No. 6,540,826 B2).

The reference teaches, an accelerator composition comprising water, aluminum sulfate, aluminum hydroxide, a 40% hydrofluoric acid solution, a complexing agent and

an amine, see the abstract, examples and the claims. According to column 4, lines 31+ the complexing agent may be selected from nitriloacetic acid, EDTA, hydroxycarboxylic acids etc. The amine may be selected from alkanol amines (see column 4, lines 44-50).

The instant claims are obvious over the reference. The examples teach compositions that render obvious the instant claims. As for aluminium sulphate being calculated on the basis of 17% aluminium sulphate, applicants particularly claimed type is a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results absent evidence showing otherwise, as 17% aluminum sulphate is a well known typical grade of aluminium sulphate. Since the hydrofluoric acid is present in a 40% solution it is believed that the amount of hydrofluoric acid would fall within the instantly claimed range. As for the complexing agent, while the example teaches EDTA, column 4, lines 31+ teach that hydroxycarboxylic acids may be used and accordingly it would have been obvious to substitute a hydroxycarboxylic acid for the EDTA of the reference. As for the amounts of the other components the reference teaches amounts that encompass those instantly claimed. However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 3-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/544,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the claims of the copending application would render obvious the instant claims..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims are encompassed by the claims of the copending application.

Information Disclosure Statement

9. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 02, 2006